

REMARKS

Applicants respectfully request entry of the foregoing and reconsideration of the subject matter identified in caption, pursuant to and consistent with 37 C.F.R. § 1.116, and in light of the remarks which follow.

Entry of this response is proper under 37 C.F.R. § 1.116 because the response places the application in condition for allowance (for the reasons discussed herein) or places the application into better form for appeal should an appeal be necessary. The response does not present any additional claims without canceling a corresponding number of finally rejected claims, does not raise the issue of new matter and does not raise any new issues requiring additional search and/or consideration since the response is directed to subject matter previously considered during prosecution. Applicants respectfully request entry of the response.

Claims 1-7 and 9-24 are pending in the application.

Applicants thank the Examiner for withdrawing the rejections under 35 U.S.C. § 103(a) over Zanker (U.S. Patent No. 3,860, 623) and Zanker in view of GB '898 (GB 955898).

Turning now to the Official Action, Claims 1-7 and 9-24 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. For at least the reasons that follow, withdraw of the rejection is in order.

The Official Action states at page 3 that the claims recite a dehydrofluorination process comprising converting carbamoyl fluoride to the corresponding isocyanate. The Official Action asserts that the claims are indefinite because they lack "those steps for specifically performing this process." Applicants respectfully disagree.

The Official Action also states that the claims are indefinite because they do not include steps of “reacting or converting carbamoyl fluoride, or recovering the corresponding isocyanate” and fail to recite any steps with regard to “handling the solvent heel.” (See Official Action at page 3.) Applicants do not understand why the Official Action suggests that the claims need to recite additional active method steps to satisfy the requirements of § 112. The Official Action cites no authority to support this position.

Independent Claims 1, 17, 18, 19 and 22 all recite one or more active method steps.

Independent Claim 1 recites a dehydrofluorination process to convert an aromatic carbamoyl fluoride to the corresponding isocyanate, the process comprising gradually introducing carbamoyl fluoride in a dissolved or finely dispersed state in a solvent into a solvent heel at a temperature of at least 80°C. (Emphasis added.)

Independent Claim 17, recites a dehydrofluorination process to convert an aromatic carbamoyl fluoride to the corresponding isocyanate, the process comprising subjecting carbamoyl fluoride to a temperature at least equal to 80°C, by gradually introducing the carbamoyl fluoride in a dissolved or finely dispersed state in a solvent at a temperature of at least 80°C, wherein the carbamoyl fluoride is introduced into the solvent with hydrofluoric acid in the form of a solution comprising anhydrous hydrofluoric acid. (Emphasis added.)

Independent Claim 18 recites a dehydrofluorination process to convert an aromatic carbamoyl fluoride to the corresponding isocyanate, the process comprising subjecting carbamoyl fluoride to a temperature at least equal to 80°C, by gradually introducing the carbamoyl fluoride in a dissolved or finely dispersed state in a solvent

at a temperature of at least 80°C so that the total yield of isocyanate is at least about 70%. (Emphasis added.)

Independent claim 19 recites a dehydrofluorination process to convert an aromatic carbamoyl fluoride to the corresponding isocyanate, the process comprising gradually introducing carbamoyl fluoride in a dissolved or finely dispersed state in a solvent into a solvent heel at a temperature of at least 80°C and wherein during introduction of the carbamoyl fluoride the ratio of hydrofluoric acid to carbamoyl fluoride is at least equal to 2. (Emphasis added.)

Independent Claim 22 recites a dehydrofluorination process to convert an aromatic carbamoyl fluoride to the corresponding isocyanate, the process comprising gradually introducing carbamoyl fluoride in a dissolved or finely dispersed state in a solvent into a solvent heel at a temperature of at least 80°C and wherein the ratio of hydrofluoric acid, including free hydrofluoric acid and added hydrofluoric acid, to isocyanate groups, real or masked in carbamoyl fluoride form, is at most equal to 5. (Emphasis added.)

Because each independent claim recites one or more active methods steps, Applicants submit that the claims satisfy the requirements of § 112. Applicants have claimed what they regard as exemplary of their invention. The Official Action has not identified any portion of the application that suggests that the invention is something different from the exemplary subject matter defined by the claims. Absent any evidence to the contrary, the Patent Office must presume that the subject matter claimed is what Applicants regard as exemplary of their invention. (See *In re Moore*, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971) and M.P.E.P. § 2172.)

The independent claims particularly point out and distinctly claim the subject matter Applicants regard as exemplary of the invention. The scope of the subject matter embraced by the claims is clear and Applicants have not otherwise indicated that they intend the claims to be of different scope. (See *In re Borkowski*, 422 F.2d 904, 164 USPQ 642 (CCPA 1970).) The Court of Appeals for the Federal Circuit has decided a number of § 112, second paragraph, cases. In these cases, the Federal Circuit has stated that indefiniteness of claim language must be analyzed, not in a vacuum, but in light of (1) the content of the particular application disclosure, (2) the teachings of the prior art, and (3) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. (See, for example, *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983).) It is well understood that the purpose of claims is not to explain the technology or how it works, but to state the legal boundaries of the patent grant. The claim is not "indefinite" simply because it is hard to understand when viewed without the benefit of the specification. (See *S3 Inc. v. nVidia Corp.*, 259 F.3d 1364, 59 USPQ2d 1745 (Fed. Cir. 2001).)

The process steps defined in independent Claims 1, 17, 18, 19 and 22, are clear when read in light of the content of the application disclosure, teachings of the prior art and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. Specifically, one of ordinary skill in the art having read the disclosure, would readily understand what the legal boundaries of the claims are. Section 112, second paragraph, does not require Applicants to meet any additional requirements.

Applicants submit that because one skilled in the art would be able to tell with a reasonable degree of certainty whether his or her conduct is within or outside the scope of these claims, the claims are neither vague nor indefinite under § 112, second paragraph. (See *In re Borkowski*.)

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of the § 112, second paragraph, rejection.

From the foregoing, Applicants earnestly solicit further and favorable action in the form of a Notice of Allowance.

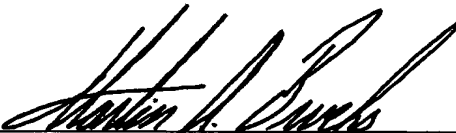
If there are any questions concerning this paper or the application in general, Applicants invite the Examiner to telephone the undersigned at the Examiner's earliest convenience.

Respectfully submitted,

BUCHANAN INGERSOLL PC

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